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IN THE

Supreme Court of the United States

OCTOBER TERM, 1950.

No. [redacted] 87

IN THE MATTER

of

The Application of HAROLD R. DALTON and AUSTIN G. COOLEY for United States Letters Patent.

HAROLD R. DALTON and AUSTIN G. COOLEY,
Petitioners,

vs.

JOHN A. MARZALL as Commissioner of Patents,
Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS.

JOHN J. ROGAN,
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Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF CUSTOMS AND PATENT APPEALS.

To the Honorable the Chief Justice and Associate Justices of the Supreme Court of the United States:

Your petitioners pray that a writ of certiorari issue to review the judgment and the final order of the United States Court of Customs and Patent Appeals dated March 6, 1951 and April 10, 1951 respectively. A petition for rehearing, and/or modification, or remand (R. 102-121) was duly filed in the said Court, which petition was denied on April 10, 1951.

Opinions Below.

The majority opinion (R. 90-96), the specially concurring opinion (R. 96-98); and the dissenting opinion (R. 98-100).

Jurisdiction.

The jurisdiction of this Court is invoked under Title 28, Section 1256 United States Code.

A certified transcript of the record in the case including the proceedings in the United States Court of Customs and Patent Appeals in compliance with Rule 38, is filed herewith.

Questions Presented.

1. **Whether the Court of Customs and Patent Appeals can deny applicants for United States Letters Patent their rights to due process of law under the Constitution of the United States, Amendment 5, by refusing to consider all the evidence as required by Sec. 4914 R. S.; Title 35, Sec. 62 U. S. C., which evidence is certified to the Court by the Commissioner of Patents as a true record for the Court.**

2. **Whether the Court of Customs and Patent Appeals can, consonant with the Constitution of the United States, Amendment 5, refuse to remand an application for Letters Patent to the Patent Office, where the Court expressly refuses to consider all the evidence, notwithstanding such evidence is certified as part of the record to the Court by the Commissioner of Patents.**

3. **Whether the Court of Customs and Patent Appeals properly construes and applies the rules of law laid down by this Court in United Carbon Co., et al., v. Binney & Smith Co., 317 U. S. 228; Halliburton Oil Well Cementing Co. v. Walker et al., doing business as Dephograph Co., 329 U. S. 1.**

4. **Whether the Court of Customs and Patent Appeals can, against the evidence of record, modify a prior art disclosure with a teaching not suggested by, or necessary to the intended mode of operation of that disclosure, and after having seen the applicant's disclosure, and thus deprive an applicant of his right adequately to claim his invention.**

Statutes and Commissioner's "Notice" Involved.

The pertinent statutory provisions, and the respondent's Notice of January 4, 1950, are printed in Appendix "A", *infra*, and the Court is asked to take judicial notice thereof.

Statement.

An application (R. 1-19) for Letters Patent was duly filed by petitioners with the Commissioner of Patents and certain claims thereof were finally rejected by the Patent Office Examiner (R. 36). An appeal was lodged with the Board of Appeals which affirmed the Examiner (R. 44-46). The only prior art reference actually relied upon by the Examiner and the Board was a patent No. 2,188,590 (R. 73-77). Both the Examiner and the Board found that there was invention in petitioners' application by allowing claim 37 (R. 89). The gravamen of the final rejection was that the rejected claims do not patentably distinguish from the said patent No. 2,188,590, under the rule of law announced by this Court in *United Carbon* v. *Binney & Smith, supra.* In order to correct a false assumption made by the Board for the first time in the case, petitioners filed a petition for reconsideration and rehearing and included as an integral part of that petition, certain affidavits and documentary exhibits (R. 52-61) to show the true meaning of the disclosure of the reference and especially the non-conducting

or insulating characteristic of the "ordinary carbon paper" of the reference. The Board considered the petition and adhered to its prior ruling (R. 62), admitting that it could find "no statement or implication" in its prior decision that "carbon paper as mentioned in the reference patent, is electrically conductive."

An appeal was duly lodged in the Court of Customs and Patent Appeals together with the reasons of appeal (R. 63-65). The record before the Commissioner of Patents as certified by him to the Court (R. 2) included the said affidavits and documentary exhibits. The Court affirmed the Board and rendered three separate opinions, a majority opinion (R. 90-96), a specially concurring opinion (R. 96-98), and a dissenting opinion (R. 98-100). The Court refused to consider all the evidence certified to it by the Commissioner (R. 95).

The majority opinion fell in with the Board's erroneous reasoning that the "ordinary carbon paper" of the reference patent when made electrically conductive *in accordance with petitioners' teaching*, negatived invention in the rejected claims, and the majority ignored the actual limitations of the rejected claims as a unitary concept. The part of the record which was certified to the Court on that issue was given no consideration by the majority, notwithstanding the mandatory directions of Sec. 4914 R. S.; 35 U. S. C. Sec. 62.

The specially concurring opinion was based upon the provisions of a certain Rule 138 (R. 96) of the Patent Office which related to the procedure in filing affidavits "after the case has been appealed" from the Primary Examiner to the Board. The Court below has no such rule of procedure and its duties are defined by Sec. 4914 R. S.

The dissenting opinion reversed the Board both on the conclusion of fact and on the conclusion of law.

Within the time provided for by the Court rules, petitioners filed a petition for rehearing (R. 102-121) setting forth grounds upon which the petitioners believed the Court had clearly erred both on law and facts, and including "Ground VII" (R. 121) specifying a denial of petitioners' rights under the "due process" clause of Amendment 5 of the Constitution of the United States, and specifying a denial of their rights to a consideration of all the evidence (Sec. 4914 R. S.). Petitioners also requested that the proceedings be remanded to the Board with instructions to remand to the Examiner to consider all the evidence of record. The Court below refused to remand (R. 123).

Specification of Errors to Be Urged.

The Court of Customs and Patent Appeals erred:

1. **In refusing to consider all the record certified to it by the Commissioner, including the affidavits and their accompanying Exhibits (R. 52-61).**

2. **In refusing to remand the case to the Commissioner for consideration of the evidence which the Court refused to consider.**

3. **In misconstruing and misapplying to the finally rejected claims the rules of law as announced by this Court in United Carbon et al., v. Binney & Smith Co., 317 U. S. 228; Halliburton Oil Well Cementing Co., v. Walker et al., doing business as Depthograph Co., 329 U. S. 1.**

4. **In ruling that petitioners' claims merely differentiate from the reference patent No. 2,188,590 by a "functional" or "use" limitation, and by construing the elements of petitioners' claims piecemeal rather than as a unitary concept.**

5. In affirming the decision of the Board of Appeals and thereby finally refusing the petitioners adequate protection for their invention under the Constitution of the United States.

Reasons For Granting the Writ.

Preliminarily it should be noted petitioners raised the Constitutional issue of deprivation of "due process" in their petition for rehearing or remand (R. 121) based upon the Court's unexpected construction of 4914 R. S. (See *Brinkerhoff-Faris Trust* v. *Hill,* 281 U. S. 673; *Saunders* v. *Shaw,* 244 U. S. 317, 320).

Reason A. It is of great importance to future litigants before the Court of Customs and Patent Appeals and in the interest of proper administration of justice in that Court to know whether or not Title 28 Sec. 1256 U. S. Code, gives the right to have this Court review failures of justice in the Court of Customs and Patent Appeals arising either by that Court refusing to consider the entire record certified to it by the Commissioner of Patents, or by that Court misapplying or misconstruing the law with respect to a case or controversy before it.

Argument.

While the Court of Customs and Patent Appeals is a legislative Court rather than a Constitutional Court, to fulfill its statutory duties it must construe and apply the law as a judicial function, as well as acting as an administrative arm of the Patent Office. The statute (Sec. 4914 R. S.) requires it to

> "hear and determine * * * on the evidence produced before the commissioner. * * *"

Certainly, in construing and applying the rules of law announced by this Court, the Court of Customs and Patent Appeals (R. 94, 96, 98) acted in a judicial capacity on a justiciable issue. As stated by Mr. Chief Justice Hughes delivering the opinion of the Court in *Federal Radio Commission* v. *Nelson Bros., B. & M. Co.*, 289 U. S. 266 at 277:

> "A finding without substantial evidence to support it—an arbitrary or capricious finding—does violence to the law. It is without the sanction of the authority conferred. And an inquiry into the facts before the commission, in order to ascertain whether its findings are thus vitiated, belongs to the judicial province and does not trench upon, or involve the exercise of, administrative authority. * * * The controlling question is whether the function to be exercised by the court is a judicial function, and, if so, it may be exercised on an authorized appeal, from the decision of an administrative body. We must not 'be misled by a name, but look to the substance and intent of the proceeding.' "

The situation as here, involved, constitutes a case or controversy within Article III, Sec. 2, Clause 1 of the Constitution of the United States.

> "It is not important * * * whether such a proceeding was originally begun by an administrative or executive determination, if, when it comes to the Court, *whether legislative or constitutional,* it calls for the exercise of only the judicial power of the court upon which jurisdiction has been conferred by law (Old Colony Trust Co. *v.* Commissioner of Internal Revenue, 279 U. S. 716, at 722). (Emphasis supplied.)

The procedure in the United States Court of Customs and Patent Appeals pursuant to Sec. 4914 R. S., "contemplates a judicial judgment" to the same extent as was ruled by

this Court in *Federal Radio Commission* v. *Nelson Bros.*, and *Old Colony Trust Co.* v. *Commissioner of Internal Revenue, supra.* See also *Pope* v. *United States,* 323 U. S. 1, at 15, 16, and other cases cited therein.

The prior ruling of this Court in *Postum Cereal Co.* v. *California Fig Nut Co.,* 272 U. S. 693 is not controlling in the present matter because:

1. That case involved merely a *registration* cancellation right under a trade-mark registration statute. The present case involves a final denial of petitioners' constitutional right to a patent *grant,* and without due consideration by the Court below of all the evidence of record, and the Postum *v.* California Fig Nut case should be read in the light of Federal Radio Commission *v.* Nelson, 289 U. S. 266; Old Colony Trust *v.* Commissioner, 279 U. S. 716; Hoover *v.* Coe, 325 U. S. 79.

2. That case was decided Jan. 3, 1927 *before* the transfer of jurisdiction from the Court of Appeals of the District of Columbia to the Court of Customs and Patent Appeals (Act of March 2, 1929, Public No. 914, 70th Congress), and *before* the enactment of Sec. 1256, Title 28, U. S. C. At the time of the Postum *v.* California Fig Nut decision, the Court of Appeals, D. C., could not render a final judgment as to whether an applicant was entitled to any given claim or claims of his pending application for Letters Patent, since the defeated applicant in that Court could initiate proceedings *de novo* in the U. S. District Court, D. C., by equity suit against the Commissioner of Patents.

On March 2, 1927 the statute was revised (35 U. S. C. Sec. 59: R. S. 4911; c. 273, Sec. 8; 44 Stat. 1336) requiring an applicant to elect whether to proceed by way of appeal to Court of Appeals, D. C., or by way of equity suit against the Commissioner. On March 2, 1929 the statute was again revised, transferring the jurisdiction from the Court of Appeals, D. C., to the Court of Customs and Patent Appeals (c. 488, Sec. 2;

45 Stat. 1476). Therefore under the existing law, once an applicant has elected to proceed by way of appeal to the Court of Customs and Patent Appeals, the ruling of that Court adverse to his claim or claims is a final one. For the convenience of this Court Appendix "B" *infra*, graphically illustrates the remedies which an applicant had before and after the Postum *v.* California Fig Nut decision.

3. The ruling of the Board of Appeals and therefore a ruling of the Court of Customs and Patent Ap-Appeals is "neither a procedural one nor an interlocutory one * * * it finally denied a patent on the claims presented", and is in the nature of a dismissal. (Hoover *v.* Coe, 325 U. S. 79, 90, which was a case involving finality of a Patent Office rejection):

> "Thus it is clear that throughout more than a century Congress has for correction of erroneous rulings, which if unreversed would end the proceedings in the Patent Office, preserved the remedy by bill in a district court either as additional to or alternative to that by summary appeal and has made the effect of adjudication in equity the same as that of decision on appeal. (Hoover *v.* Coe, 325 U. S. 79, at 87, 88.)

4. The Commissioner of Patents who is the respondent here, treats the rulings of the Court of Customs and Patent Appeals as final. (See Commissioner's Notice of January 4, 1950, Vol. 630 Official Gazette United States Patent Office, page 617, which for the convenience of the Court is included in Appendix "B" *infra* and as to which this Court is respectfully asked to take judicial notice.)

5. As a matter of actual practice the Court of Customs and Patent Appeals acts on appeals from the Patent Office in a judicial rather than in an administrative manner.

Reason B. If this writ is not granted, the ruling of the Court below will be final on the petitioners' right to a patent on the rejected claims and notwithstanding that the Court below refused to consider all the evidence certified to it as regards the actual teaching of the reference patent, and has refused to remand to have that evidence considered.

Argument.

For the first time in the proceedings, the Board of Appeals injected the proposition that the reference patent No. 2,188,590 (R. 45) discloses a duplicating *coating* which "may be ordinary carbon paper." The record clearly shows that "ordinary carbon paper" is an insulator and does not have the physical characteristic of being "electrically conductive" which is a *sine qua non* of certain of the rejected claims, and as expressly set forth therein both by way of the preamble of the claim and by way of the claim element (See claim 25, R. 86). The reference patent is by reason of its own teaching entirely silent on that all-important physical characteristic. The Examiner never took the position that the reference patent discloses an electrically conductive carbon paper, and indeed he could not do so since there is nothing in that patent to indicate or even suggest that "ordinary carbon paper" has the property of electric conductivity. On reconsideration the Board surmised that since petitioners' composite dye-carbon duplicating coating is electrically conductive, then the "ordinary carbon paper" of the reference must also be electrically conductive. Neither the Board nor the Court had the right to refuse the petitioners' claims on the basis of information derived from the petitioners' own disclosure, and against the evidence of record.

The Patent Office Rule 138 which the concurring opinion below refers to (R. 96), has no application to the filing of affidavits *after* an appeal has been decided by the Board, but only to the filing of affidavits in the interim between the final rejection of the Examiner and before the Board has decided. The affidavits which the Court refused to consider were filed *as a result* of that Board for the first time surmising that the non-conductive "ordinary carbon paper" of the reference is structurally the same as petitioners' *composite* dye-carbon coating which is electrically conductive. The petitioners' had no way of knowing in advance, that the Board would make an erroneous assumption and thereby inject a new issue into the proceeding. The specially concurring opinon below ruled that since petitioners had not specifically referred to said affidavits in their reasons of appeal, the Court had no jurisdiction to consider them. The Board never stated that it had not considered the affidavits, and petitioners were entirely within their rights in believing that the Board had considered them. There is nothing in the record to support the Court's "guess" that the Board had not considered the affidavits. The record certified by the Commissioner to the Court speaks for itself and is binding as the record of evidence which the Court should have considered. Even if the Court had been ignoring such evidence in prior cases, that is no basis for it continuing the error. The doctrine of *stare decisis* is no justification for a Court voluntarily curtailing its own jurisdiction as set forth in the enabling Statute (35 U. S. C., Sec. 62; Sec. 4914 R. S.). Furthermore the petitioners' reasons of appeal (R. 63-65) were entirely adequate to support the Court's jurisdiction to consider the evidence certified to it by the Commissioner. The Court erroneously construed the Statute as if it read "on

the evidence considered by the Board of Appeals", whereas the Statute broadly states "on the evidence produced before the commissioner." The record certified by the commissioner contains the evidence which the Court refused to consider.

Reason C. The Court below in its majority opinion stated, without any basis in the record, that the Board of Appeals did not consider the evidence of the said affidavits. It was therefore the duty of that Court to remand the case to the Patent Office to consider the evidence.

Argument.

Fundamental equity requires that when a lower tribunal certifies a record to an appellate tribunal as including certain evidence, the appellate tribunal is not at liberty to guess or surmise as to what was not considered by the lower tribunal. The Commissioner of Patents who certified the record to the Court is the respondent here, and is bound by his own certified record (Rule 16 of this Court).

Reason D. The Court below misconstrued and misapplied the rule of law announced by this Court in United Carbon v. Binney & Smith, 317 U. S. 288; and Halliburton v. Walker et al. 329 U. S. 1.

Argument.

The Court below based its conclusions of law on the premise that the physical characteristic "electrically conductive" renders the claims indefinite, relying on the *United Carbon,* and the *Halliburton* cases *supra.* The rejected claims are not indefinite under the reasoning and decision in the *United Carbon* case because the type of claim in that

case was a *single* means claim and the patentee was endeavoring to rely on such expressions as "substantially pure", "commercially uniform", "comparatively small" which the Court found were insufficient to enable the public to determine where infringement might begin and where it might end. There is no such situation presented in petitioners' rejected claims. The record clearly shows that infringement can be avoided by using a non-conductive blank or an "ordinary carbon paper" such as taught by the reference. The claim in the *United Carbon* case used the expression "approximately one-sixteenth of an inch" but the record in that case showed that the plaintiff was endeavoring to extend that precise dimensional limitation to bring in as an infringement, dimensions of 1/4th to 1/100th of an inch. The record in this case shows beyond the peradventure of a doubt that the claims if allowed to petitioners could never be asserted as covering the blank of the reference patent. There would be an estoppel or record against petitioners. Petitioners' claims such as claims 23, 25, 26-32 do not rely on such indefinite functional expressions as in the *United Carbon* case, but on a definitely ascertainable physical characteristic namely that the *composite* dye-carbon coating is **electrically conductive**, as distinguished from **electrically insulating.**

The rejected claims are not *single* means claims, as in the *United Carbon* case, but are for a novel combination comprising three distinct structural elements, (1) pliable paper backing, (2) *composite* carbon-dye coating which is also electrically conductive, (3) a contrasting overall masking coating (R. 6, 7, 19). This combination of elements with the property of electric conductivity in the dye coating is not found in the reference which is in no way concerned with electric conductivity. The record before this Court shows beyond any doubt that the blank of the reference is

not electrically conductive. The Court below erroneously assumed, in spite of the record, that the rejected claims merely differ from the reference by the property of electric conductivity. Even if the Court's assumption had been correct, its conclusion of law that a "property" limitation is not countenanced by the prior rulings of this Court, is in itself reversible error.

In *Halliburton* v. *Walker, supra,* this Court ruled that the vice in the claims then before it was that they attempted to distinguish the most crucial element in the new combination "in terms of what it will do rather than in terms of *its own physical characteristics*" (329 U. S. 1, at 9). The limitation "electrically conducting" or "electrically conductive" is not a mere "use" limitation, but is a true physical property or characteristic limitation, which this Court inferentially, at least, has indicated is proper (see also *Holland Furniture Co.* v. *Perkins Glue Co.,* 277 U. S. 245, 256). Furthermore the *ratio decidendi* of the *Halliburton* case was, as in the *United Carbon* case, that the public could not know where infringement began and where it stopped. The petitioners would obviously be estopped by the record here to contend that their claims cover a blank which does not have a composite dye-carbon coating and which is electrically non-conducting. The public is clearly free to use the blank of the reference without infringing petitioners' claims.

The rejected claims, of which claim 25 is typical would appear to be within the purview of the type of claim that was approved by this Court in *Goodyear Tire & Rubber Co.* v. *Ray-O-Vac Co.,* 321 U. S. 275, and in *Faulkner* v. *Gibbs,* 338 U. S. 267.

Reason E. The single prior art reference upon which the Board and Court below relied, discloses a different combination wherein electric conductivity is of no utility, whereas the property of electric conductivity gives life and meaning to petitioners' claims.

Argument.

Petitioners' blank as covered by claims 23, 25, 26-32 is an electro-sensitive one, constructed and designed for the recording and duplicating of electric telefacsimile signals. The blank of the reference is intended for use in a typewriter or similar type-bar machine. Therefore petitioners' claims must not have their elements construed piece-meal so as to compare them if possible with elements of the reference, but should be construed as a *unitary concept* so that the entire setting of the claim language may be properly understood in the light of the problem that is solved. In such a situation the preamble to the claims cannot be ignored, particularly when the physical characteristic of electric conductivity in the composite dye-carbon coating is unavoidably tied in with the preamble to the claim. The reference completely fails as a disclosure of an electro-sensitive blank which is specially designed to record and respond to applied electric signals. The record certified to the Court below and to this Court, shows beyond any doubt, not only is the blank of the reference non-conductive, but that the physical characteristic of electric conductivity has no significance or utility therein. Neither the Board nor the Court could justifiably read into the reference a disclosure of electric conductivity not contained therein either expressly or by implication, and to do so would be against the intended mode of operation of the reference. (*Carnegie Steel Co.* v. *Cambria Iron Co.*, 185 U. S. 403). In the ab-

sence of petitioners' disclosure, no one reading the reference would realize the importance of having an electrically conductive blank merely because it refers to "ordinary carbon paper." The knowledge used by the Board and the Court below to reject petitioners' claims was knowledge acquired "after the event" and after having seen petitioners' disclosure. (*Diamond Rubber Co.* v. *Consolidated Tire Co.*, 220 U. S. 428, 435).

Conclusion.

For the foregoing reasons, this petition for a writ of certiorari should be granted.

Respectfully submitted,

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CHARLES A. MORTON,
Of Counsel.

May 25, 1951.

Appendix A.

Pertinent Statutes & Commissioner's "Notice" With Pertinent Parts Emphasized.

28 U. S. C. Sec. 1256.

Cases in the Court of Customs and Patent Appeals may be reviewed by the Supreme Court by writ of certiorari (June 25, 1948, c. 646, Sec. 1, 62 Stat. 928).

28 U. S. C. Sec. 1542.

The Court of Customs and Patent Appeals shall have jurisdiction of appeals from decisions of:

(1) the Board of Appeals and the Board of Interference Examiners of the Patent Office as to patent applications and interferences, at the instance of an application for patent or any party to a patent interference, *and such appeal by an applicant shall waive his right to proceed under Section 63 of Title 35;* and • • • (June 25, 1948, c. 646 Sec. 1, 62 Stat. 942).

Statute before repeal or amendment	Present Statute
Sec. 4911 R. S. (35 U. S. C. Sec. 59).	Sec. 4911 R. S. (35 U. S. C. Sec. 59a).
The determination of appeals from the decision of the Commissioner of Patents is vested in the Court of Appeals of the District of Columbia; • • • (repealed Mar. 2, 1927).	If any applicant is dissatisfied with the decision of the board of appeals, he may appeal to the United States Court of Customs and Patent Appeals, *in which case he waives his right to proceed under section 63 of this title* • • • (R. S. 4911) (Mar. 2, 1927, c. 273, sec. 8, 44, Stat. 1336; Mar. 2, 1929, c. 488, sec. 2, 45, Stat. 1476).

Sec. 4915 R. S. (35 U. S. C. Sec. 63).

Whenever a patent on application is refused, either by the Commissioner of Patents or by the Court of Appeals of the District of Columbia upon appeal from the Commissioner, *the applicant may have remedy by bill in equity;* * * *

Sec. 4915 R. S. (35 U. S. C. Sec. 63).

Whenever a patent on application is refused by the Board of Appeals or whenever any applicant is dissatisfied with the decision of the board of interference examiners, the applicant, *unless appeal has been taken to the United States Court of Customs and Patent Appeals,* and such appeal is pending or has been decided, may have remedy by bill in equity, if filed within six months after such refusal or decision; * * * (R. S. 4915).

(Mar. 2, 1929, c. 488, sec. 2(b), 45 Stat. 1476; August 5, 1939, c. 451, sec. 4, 53 Stat. 1212).

Act of March 2, 1929 (Public No. 914, 70th Congress)

Sec. 2(a). The jurisdiction now vested in the Court of Appeals of the District of Columbia in respect of appeals from the Patent office in patent and trade-mark cases is vested in the United States Court of Customs and Patent Appeals (Mar. 2, 1929, c. 488, Sec. 1, 45 Stat. 1475).

Sec. 4912 R. S. (35 U. S. C. Sec. 60).

When an appeal is taken to the United States Court of Customs and Patent Appeals, the appellant shall give notice thereof to the commissioner, and file in the Patent Office, within such time as the commissioner shall appoint, his reasons of appeal, specifically set forth in writing.

Sec. 4914 R. S. (35 U. S. C. Sec. 62).

The court, on petition, *shall hear and determine such appeal,* and revise the decision appealed from in a summary way, *on the evidence produced before the commissioner* at such early and convenient time as the court may

appoint and the revision shall be confined to the points set forth in the reasons of appeal. After hearing the case the court shall return to the commissioner a certificate of its proceedings and decision, which shall be entered of record in the Patent Office, *and shall govern the further proceedings in the case.* But no opinion or decision of the court in any such case shall preclude any person interested from the right to contest the validity of such patent in any court wherein the same may be called in question.

Sec. 4913 R. S. (35 U. S. C. Sec. 61).

The court shall, before hearing such appeal give notice to the commissioner of the time and place of the hearing, and on receiving such notice the commissioner shall give notice of such time and place, in such manner as the court may prescribe, to all parties who appear to be interested therein. The party appealing shall lay before the court certified copies *of all the original papers and evidence in the case,* and the commissioner shall furnish the court with the grounds of his decision, fully set forth in writing touching all the points involved by the reasons of appeal.

Commissioner of Patents Notice of January 4, 1950 (Vol. 630 O. G. No. 3 p. 617).

1. *Purpose of Notice.* This notice sets forth the present position of the Office concerning the status of an application following ex parte appeal to the Court of Customs and Patent Appeals. Any prior decisions or instructions of the Commissioner inconsistent with this Notice are overruled from the date hereof.

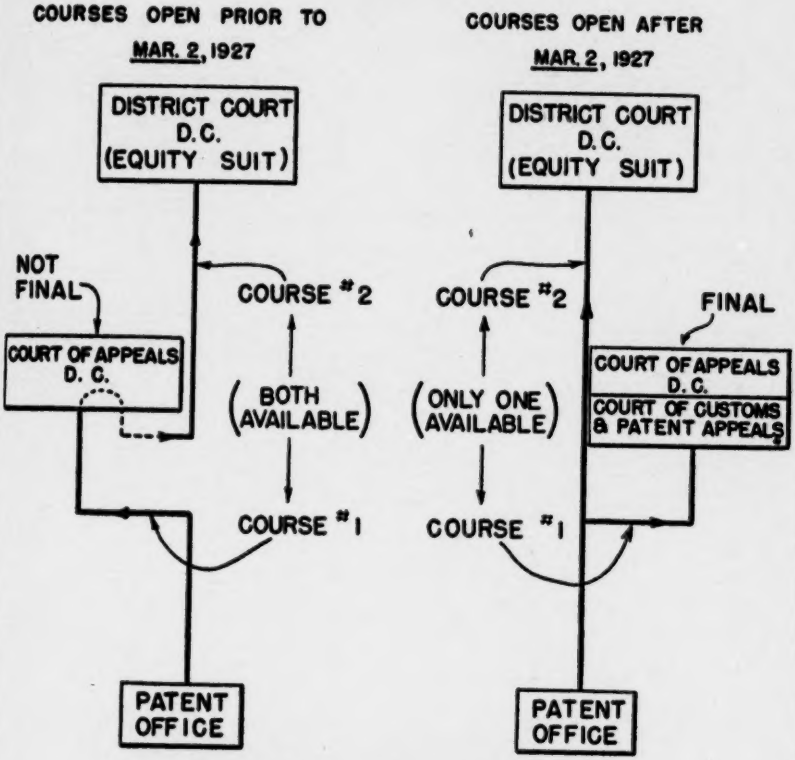
2. *Certificate of the Court.* After hearing the case the court returns to the Office "a certificate of its proceedings and decision, which shall be entered of record in the Patent Office, and shall govern the further proceedings in the case" (R. S. 4914; 35 U. S. C. 62). The receipt of this certificate by the Office marks the conclusion of the appeal.

3. *All claims rejected.* If all claims in the case stand rejected, proceedings on the application are considered terminated on the date of receipt of the Court's certificate and the application is not open to subsequent amendment and prosecution by the applicant. The application is no longer considered pending.

4. *Some claims allowed.* If some claims in the case stand allowed, either by reversal of the Office decision by the Court or by having been allowed by the Examiner or the Board of Appeals, proceedings are considered terminated as to the rejected claims. Action by the applicant canceling the rejected claims is not considered necessary. The Examiner will pass the case for issue forthwith on the allowed claims, the applicant being advised of such action. The rejected claims may be canceled by the Examiner with an appropriate notice on the margin, to avoid confusion of the printer. However, if formal matters remain to be attended to, the Examiner should take appropriate action on such matters, setting a shortened period for reply, but the application is considered closed to further prosecution except as to such matters.

APPENDIX "B"

POSTUM V. CALIFORNIA FIGNUT (272 U.S. 693)
DECIDED
JAN 3, 1927



*JURISDICTION OF COURT OF APPEALS D.C. IN PATENT OFFICE APPEALS TRANSFERRED TO COURT OF CUSTOMS AND PATENT APPEALS MAR. 2, 1929